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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,354	02/14/2001	Sydney D. Daniel	IRC293-14060/205649	1055
23370	7590	06/21/2004	EXAMINER	
JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET SUITE 2800 ATLANTA, GA 30309			JUSKA, CHERYL ANN	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 06/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

SUPPLEMENTAL Office Action Summary	Application No.	Applicant(s)	
	09/783,354	DANIEL ET AL.	
	Examiner	Art Unit	
	Cheryl Juska	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.135(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 25 February 2004.

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-19, 21-24, 27-30, 40-45, 47 and 49-95 is/are pending in the application.

4a) Of the above claim(s) 40-45, 79-81 and 87-92 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-19, 21-24, 27-30, 47, 49-78, 82-86 and 93-95 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date, <u>02/25/04</u> . 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____.
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U.S. Patent and Trademark Office

Application/Control Number: 09/783,354
Art Unit: 1771

Page 2

**SUPPLEMENTAL
DETAILED ACTION**

1. In response to the applicant interview of February 25, 2004, a supplemental Office Action is being issued to add a 112, 1st rejection that was previously overlooked. Thus, the below Office Action is a duplicate of the Office Action mailed December 17, 2003, with the added sections highlighted in bold text.

Response to Amendment

2. Applicant's amendment filed September 15, 2003, has been entered. Claim 1 has been amended as requested. New claims 49-95 have been added. Claims 20, 25, 26, 31-39, 46, and 48 are cancelled. Thus, the pending claims are 1-19, 21-24, 27-30, 40-45, 47, and 49-95.

3. As discussed during the interview of September 12, 2003, all the standing 112 and prior art rejections are hereby withdrawn. However, new 112, 1st and 2nd rejections are made as set forth below. Additionally, even though it was said at the interview that the limitation of "without pattern alignment" might not be needed to overcome the prior art of Eusemann, said art is applied against those claims which lack said limitation. The change in heart was due to the following factors: (a) review of the entire application prosecution history which was unavailable at the time of the interview, (b) a clearer understanding of the scope of the term "orthogonally ambiguous" as defined in the specification, and (c) a closer reading of Eusemann, which teaches a random layout of the patented tiles.

4. Furthermore, the phrase "without pattern alignment between adjacent tiles" is not considered new matter based upon applicant's persuasive arguments presented with the

Application/Control Number: 09/783,354
Art Unit: 1771

Page 3

Amendment of September 15, 2003. Also, since said phrase is not explicitly defined in the specification, for the purposes of examination, it is stated that said phrase is given the meaning intended in the specification, which is consistent with the common understanding of the carpet tile art. Hence, the phrase "without pattern alignment between adjacent tiles" means that the edges or the periphery of pattern shapes on one carpet tile do not align or match up with the edges or periphery of pattern shapes on an adjacent carpet tile when said tiles are arranged side-by-side in a floorcovering installation.

Election/Restrictions

5. An original restriction requirement was made by the former examiner in Paper No. 2 mailed on March 28, 2002. Said restriction was between product claims and method claims. Applicant made a provisional election with traverse to the product claims.

6. In the next Office Action (Paper No. 11, mailed on October 30, 2002), the former examiner made a five-way restriction consisting of the following groups:

- I. Carpet tiles.
- II. A web.
- III. A floorcovering.
- IV. A method of making carpet tiles.
- V. A method of making a floorcovering.

Applicant responded in Paper No. 12 on November 15, 2002 with an election with traverse of Group I, the carpet tiles.

7. As mentioned in the Interview of September 12, 2003, a restriction requirement is being reinstated below. However, said restriction is narrowed to a three-way restriction in view of applicant's traversal to the five-way restriction (Amendment B, Paper No. 12, page 4).

Application/Control Number: 09/783,354

Page 4

Art Unit: 1771

8. Restriction to one of the following inventions is required under 35 USC 121:

- I. Claims 1-19, 21-24, 27-30, 47, 49-78, 82-86, and 93-95, drawn to carpet tiles, an assembly of tiles, and a floorcovering of tiles, classified in class 428, subclass 44+.
- II. Claims 79-81, drawn to a carpet web, classified in class 428, subclass 85+.
- III. Claims 40-45 and 87-92, drawn to a method of making a floorcovering and a method of making tiles, classified in class 52, subclass 741.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a broadloom carpet and the inventions are deemed patentably distinct since there is nothing on record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 USC 103(a) of the other invention.

Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). In the instant case, the

Application/Control Number: 09/783,354
Art Unit: 1771

Page 5

process can be made to make non-orthogonally ambiguous carpet tiles or carpet tile floorcoverings.

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). In the instant case, the product can be used as a broadloom carpet floorcovering rather than being used to make carpet tile floorcoverings.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Due to applicant's prior elections to the product claims in general, and the carpet tiles claims, in particular, the election stands, with traverse, as Group I, claims 1-19, 21-24, 27-30, 47, 49-78, 82-86, and 93-95, drawn to carpet tiles, an assembly of tiles, and a floorcovering of tiles. Claims 40-45, 79-81, and 87-92 are withdrawn as non-elected.

Drawings

9. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Figure 1 illustrated the carpet web before cutting into tiles, while Figures 2 and 3 each show two of the inventive tiles in exemplary orientations. However, the drawings do not show the claimed final product of a floorcovering showing orthogonal ambiguity. Therefore, the orthogonal ambiguity of the tiles in a floorcovering

Application/Control Number: 09/783,354

Page 6

Art Unit: 1771

installation (i.e., more than two tiles) must be shown or the feature canceled from the claims. No new matter should be entered. It is suggested applicant submit drawings showing two or three different arrangements of the randomly oriented carpet tiles in a floorcovering.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-19, 21-24, 27-30, 47, 49-78, 86, and 93-95 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claim 1 is recited carpet tiles exhibiting "orthogonal ambiguity without pattern alignment between adjacent tiles." The definition of tiles that exhibit "orthogonal ambiguity" is set forth in the specification, page 2, 2nd paragraph, as tiles that "may be laid in any side-by-side orientation with respect to adjacent tiles without looking out of place to the ordinary viewer and thereby still achieving an appearance of continuity across the entire installation as if the tiles were part of a broadloom web." Hence, said definition is dependent upon the tiles being placed in adjacent relationship as a floorcovering installation. An individual carpet tile or a plurality of carpet tiles uninstalled cannot by definition, exhibit "orthogonal ambiguity." Hence, the presence of the property of "orthogonal ambiguity" or lack thereof cannot be properly determined based upon

Application/Control Number: 09/783,354

Page 7

Art Unit: 1771

individual tiles or a plurality of uninstalled carpet tiles. Thus, claim 1 is rejected as indefinite because it is unclear that the claimed tiles are arranged in such an installation. In other words, the current claim does not positively recite that said tiles are assembled on a flooring surface so that each tile is adjacent to and abutting at least one other tile. Claims 2-19 and 27-30 are rejected for their dependency upon claim 1. Additionally, claims 49-74 are similarly rejected.

13. Claim 93 is indefinite because it is unclear that the assembly of carpet tiles is laid as a floorcovering installation. In its broadest sense, an "assembly of carpet tiles" can be a stack of tiles or a scattered arrangement of tiles in a non-abutting relationship. The limitations of "no tile looking out of place" and "the appearance of continuity" do not necessarily imply that said assembly is a floorcovering installation. Thus, said claim is rejected as indefinite. Claim 95 is similarly rejected. Additionally, it is argued that claims 47 and 94 are indefinite since the language of "an assembly of side-by-side carpet tiles" could still describe a stack of tiles.

14. Claims 1-19, 21-24, 27-30, and 49-78 are also rejected as indefinite for claiming the carpet tiles in terms of a property instead of the structural or chemical features that produce said property and which would distinguish said tiles from other prior art carpet tiles. *Ex parte Slob*, 157 USPQ 172, states the following:

Claims merely setting forth physical characteristics desired in article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired characteristics; thus, expression "a liquefiable substance having a liquefaction temperature from about 40°C. to about 300°C. and being compatible with the ingredients in the powdered detergent composition" is too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition, and, in effect, recites compounds by what it is desired that they do rather than what they are; expression also is too broad since it appears to read upon materials that could not possibly be used to accomplish purposes intended.

Application/Control Number: 09/783,354
Art Unit: 1771

Page 8

In other words, the claims lack clarity of the combined structural features of the design pattern that provide the property of "orthogonally ambiguous." Some of these features include the plurality of colors, the plurality of shapes, the relationship of said shapes to the tile edge, and the relationship of the colors and shapes in adjacent tiles, and the relationship of the overall pattern of each tile to the other tiles (i.e., not identical). Note that claims 24, 74, and 78 come close to claiming the combination of structural features which produce the "orthogonal ambiguity," but fall short of reciting the full combination of features required. Note the specification, page 4, line 4 through bottom of page 5, which discusses a number of factors which contribute to the orthogonal ambiguity of the carpet tiles and the "rules" for creating a pattern according to the invention.

15. Claim 47 also rejected as indefinite under *Ex parte Slob*. Although the term "orthogonally ambiguous" not recited in claim, **said claim is dependent upon claim 1.** **Additionally**, the definition of said term is recited in part (i.e., "the appearance of the tiles continuous across the assembly so that no tile looks out of place or out of position in any place or position in the assembly"). Thus, the claim is indefinite since the combination of structural features of the pattern of colors and shapes which "renders the appearance" orthogonally ambiguous are not recited. Claim 86 and 93-95 are similarly rejected.
16. Claims 24, 62, 74, and 78 are indefinite because it is unclear if the phrase "adjacent shapes" refers to shapes on adjacent tiles or adjacent shapes within a single tile.
17. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Application/Control Number: 09/783,354

Page 9

Art Unit: 1771

18. Claims 47, 86, and 94 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claim 86 includes the limitation "without the locations at which adjacent tiles abut being visually prominent," while claims 47 and 94 include the limitation "a pattern not identical to any other tile of the assembly." Both limitations are considered negative limitations. According to MPEP 2173.05(i), "Any negative limitation or exclusionary proviso must have basis in the original disclosure....See also *Ex parte Grasselli*, 231 USPQ 393The mere absence of a positive recitation is not basis for an exclusion. The specification fails to provide support for both said negative limitations. Hence, claims 47, 86, and 94 are rejected as containing new matter.

19. Claims 1-19, 21-24, 27-30, 47, 49-78, 86, and 93-95 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "orthogonally ambiguous" carpet tiles having a pattern thereon wherein said pattern is produced by the method of factors and rules set forth in the specification at page 4, line 1-page 5, line 21 does not reasonably provide enablement for (a) all "orthogonally ambiguous" carpet tiles not having pattern alignment, as is presently recited in claims 1-19, 21-24, and 27-30, (b) all "orthogonally ambiguous" carpet tiles as recited in claims 49-78, and (c) all carpet tiles having features of the definition of "orthogonally ambiguous" as recited in claims 47, 86, and 93-95. The specification does not enable any person skilled in the art to which it

Application/Control Number: 09/783,354
Art Unit: 1771

Page 10

pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Specifically, the specification discloses a particular method of making a patterned carpet tile which exhibits orthogonal ambiguity upon installation. However, applicant attempts to claim all orthogonally ambiguous carpet tiles (with or without pattern alignment) and asserts that the first to invent something new deserves to get broad coverage of the invention in the claims. While this assertion may be true, applicant has not invented the concept of orthogonally ambiguous carpet tiles [note Eusemann's teaching of tiles capable of being laid in a random rotation for foolproof installation, col. 2, lines 49-54). While it is clear Eusemann's tiles have orthogonal ambiguity with pattern alignment, applicant's claims are still broader in scope than what is originally disclosed.

What applicant has invented is a particular carpet tile pattern which enables the tile to be laid in any random orientation upon installation without pattern alignment. This design feature is applicant's contribution to the art. Applicant has not invented all presently known or future known patterns which enable orthogonal ambiguity and as such, is not entitled to a patent for such. Applicant's own filing of two continuation-in-part applications claiming priority to the present application supports the examiner's position. In particular, if applicant had invented the general concept of orthogonally ambiguous carpet tiles, then at least the two CIP applications would contain no new patentable feature. Rather, as evidenced by said CIP's, applicant's present disclosure is to one particular method of producing a pattern for a carpet tile whereby said tile exhibits orthogonal ambiguity and the tile produced therefrom, while the two CIP's disclose other methods and

Application/Control Number: 09/783,354

Page 11

Art Unit: 1771

products that obtain the same goal of orthogonal ambiguity. Therefore, claims 1-19, 21-24, 27-30, 47, 49-78, 86, and 93-95 are rejected as being non-enabled for the scope of the claims.

Claim Rejections - 35 USC § 102

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

21. Claims 82-85 are rejected under 35 USC 102(b) as being anticipated by US 3,875,716 issued to Eusemann.

Claim 82 is drawn to a carpet tile cut from the web of claim 79. The resulting product (i.e., single carpet tile) has the structural limitation that a portion of a shape from the web appears on the tile and said shape has an edge that parallels at least one edge of the carpet tile. Claim 83 limits the tile to being a square. Claim 84 limits the tile to having a shape with a straight edge which parallels a first pair of opposed edges of the tile and a straight edge which parallels a second pair of opposed edges of said tile. Claim 85 is drawn to a floorcovering comprising a plurality of tiles cut from the web, wherein said tiles have a common color. [Note claims 82-85 do not limit the tiles or floorcovering to having orthogonal ambiguity.]

Eusemann discloses a floorcovering of carpet tiles, wherein each tile comprises a portion of a shape having one straight edge which parallels a first pair of opposed tile edges and a second straight

Application/Control Number: 09/783,354

Page 12

Art Unit: 1771

edge which parallels a second pair of opposed tile edges. (See Figures 2 and 3.) Additionally, the tiles have one color in common. Thus, claims 82-85 are anticipated by Eusemann.

22. Claims 49-52, 54-59, 61-64, 75, 86, 93, and 95 are rejected under 35 USC 102(b) as being anticipated by US 3,875,716 issued to Eusemann.

Eusemann discloses carpet tiles having partitioned pattern shapes (Figures 1, 4, and 7). Said tiles may be woven or tufted carpet tiles (col. 2, lines 15-18). Eusemann explicitly teaches that said carpet tiles may be laid in a scattered or completely irregular pattern of rotation so that installation is foolproof (col. 2, lines 49-54). Thus, the tiles can be laid in any side-by-side orientation with respect to adjacent tiles without looking out of place (i.e., orthogonally ambiguous). Additionally, Figures 2 and 3 of Eusemann show floorcovering wherein the locations at which adjacent tiles abut are not visually prominent. Thus, said claims are anticipated by Eusemann.

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claim 53 is rejected under 35 USC 103(a) as being unpatentable over the cited Eusemann patent.

Although Eusemann does not explicitly teach fusion bonded carpet tiles, it would have been obvious to one skilled in the art to employ a textile face comprised of fusion bonded carpet pile since said fusion bonded carpets are well known in the art as equivalent carpet structures to tufted carpets. Applicant is hereby given Official Notice of this fact. Thus, it would have been obvious to one skilled

Application/Control Number: 09/783,354

Page 13

Art Unit: 1771

in the art to employ a fusion bonded carpet tile for the tile of Eusemann, since said tiles are art recognized equivalents to tufted carpet tiles.

25. Claim 60, 65-73, and 76-78 are rejected under 35 USC 103(a) as being unpatentable over the cited Eusemann patent

With respect to claims 60, 67, and 71, Eusemann fails to teach colors of the same intensities. However, it would have been obvious to one skilled in the art to select colors for the patterned carpet tile that have similar intensities in order to create an aesthetically pleasing floorcovering. Additionally, one would be motivated to select colors of like intensities so that when assembled in the "foolproof" scattering method, the tiles would seem to be more coherent.

With respect to claims 66, 70, and 76-78, Eusemann fails to explicitly teach tiles of more than two colors. However, it would have been obvious to one of ordinary skill in the art to select more than two colors, in particular, three colors, so as to provide an aesthetically pleasing carpet tile floorcovering.

With respect to claims 65, 68, 69, 72, and 73, Eusemann fails to teach one shape comprising two or three colors. As noted above, the selection of colors, including the number of colors within a particular shape, would have been obvious to one skilled in the art as a means of providing a variety of decorative and aesthetically pleasing carpet tiles. Therefore, claims 60 and 65-73 are rejected as being obvious over the cited Eusemann patent.

26. Claim 74 is rejected under 35 USC 103(a) as being unpatentable over the cited Eusemann patent.

Claim 74 is drawn to orthogonally ambiguous carpet tiles comprising a pattern of shapes, at least one of said shapes on each tile is formed by a straight line oriented parallel to an edge of the carpet tile. Claim 74 also limits the colors of at least four shapes to comprise specific combinations of a background

Application/Control Number: 09/783,354
Art Unit: 1771

Page 14

color, a first color, a second color, and a third color, wherein adjacent shapes on the tiles comprise at least one common color.

Eusemann does not explicitly teach the claimed color and shape combinations, but, as discussed above, it would have been obvious to one skilled in the art to vary the selection of color combinations in order to create a variety of aesthetically pleasing carpet tile patterns. Therefore, claim 74 is rejected.

Response to Arguments

27. Applicant's arguments submitted with the proposed amendment of the interview of February 25, 2004, have been fully considered but they are not persuasive.

28. In particular, applicant traverses the 112, 2nd indefinite rejection for claiming the carpet tiles in terms of a property (i.e., orthogonal ambiguity) instead of the structural or chemical features that produce said property and which would distinguish said tiles from other prior art carpet tiles (i.e., *Slob* rejection) by asserting that a claim is definite because the term "orthogonal ambiguity" is clearly defined in the specification. The examiner does not dispute this, but asserts that without chemical and/or structural features that produce this property of orthogonal ambiguity, the claim covers any orthogonally ambiguous carpet tile presently known or that might be known in the future. This is clearly beyond the scope of the claimed invention.

29. With respect to applicant's assertion that the examiner is confusing the 112, 2nd rejection with a prior art rejection (i.e., requiring the structural features to be added to the claim in order to distinguish the present invention from the prior art), the examiner contends applicant has misunderstood the examiner's comments. "What chemical or

Application/Control Number: 09/783,354
Art Unit: 1771

Page 15

structural features distinguish the present invention from the prior art?" is merely an argumentative point in the 112, 2nd rejection. In other words, in order to compare the instant invention with the prior art, it is necessary to first determine what the invention is. The present claims fail to provide the necessary clarity to define the scope of the invention. It is necessary that the product be described with sufficient particularity that it can be identified so that one can determine what will and will not infringe. *Benger Labs., Ltd. V. R.K. Laros Co.*, 135 USPQ 11; *In re Bridgeford*, 149 USPQ 55; *Locklin et al. v. Switzer Bros., Inc.* 131 USPQ 294. Reciting the physical and chemical characteristics of the claimed product will not suffice where it is not certain that a sufficient number of characteristics have been recited that the claim reads only on the particular compound which the applicant has invented. *Ex parte Siddiqui* 156 USPQ 426; *Ex parte Davission et al.* 133 USPQ 400; *Ex parte Fox* 128 USPQ 157.

30. With respect to applicant's assertion that functional language is perfectly acceptable claim language according to MPEP 2173.05(g), first it is argued that *Ex parte Slob* states, "Claims...are invalid as vague, indefinite, and functional...." Thus, Slob says the entire claim is functional, not necessarily the individual limitation of said claim. MPEP 2173.05(g) is directed to functional limitations within a claim. Specifically, "A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step." Examples of functional limitations are given as 'a radical on a chemical compound incapable of forming a dye with said oxidizing developing agent,' 'members adapted to being positioned,' and 'portions being resiliently dilatable whereby said housing may be

Application/Control Number: 09/783,354

Page 16

Art Unit: 1771

slidably positioned.' In most of the claims in question, applicant merely claims the particular capability or purpose, but does not claim a recited element, ingredient, or step that is achieved thereby. Thus, the claimed limitation of orthogonal ambiguity is not considered a functional limitation according to MPEP 2173.05(g). Additionally, for the claims that might be considered to contain functional limitations, "functional" is not equivalent to "definite." The cited MPEP section does not state that all functional limitations inherently meet the 112, 2nd requirement of definiteness. In other words, a limitation could be both functional and indefinite at the same time.

31. Applicant relies upon *In re Roberts*, 176 USPQ 313, stating "[t]he absence in the claim[s] of specific [features] which would bring about the desired [] property is no defect. The claims define the limits of the claimed invention, and it is the function of the specification to detail how this invention is to be practiced." The examiner notes that the proper quote is "Absence in claim of specific *steps* which would bring about desired property is no defect..." [Emphasis added.] Specifically, *In re Roberts* is directed to issues regarding 112, 6th paragraph, step plus function language. Thus, the examiner asserts said case law is not applicable to the present situation.

32. Additionally, applicant relies upon *In re Swinehart*, 169 USPQ 226, stating *Ex parte Slob* is superceded by *Swinehart*. According to *Swinehart*, "functional" language in and of itself, does not render a claim improper. The examiner does not refute this. Nor, as discussed above, does the examiner contend the claims are indefinite for their use of functional language. However, *Swinehart* states, "Assuming that applicant is claiming what he regards as his invention, there are in reality only two basic grounds for rejection

Application/Control Number: 09/783,354

Page 17

Art Unit: 1771

claim under 35 USC 112, first is that language used is not precise and definite enough to provide clear-cut indication of the scope of subject matter embraced by claim; this ground finds its basis in second paragraph of section 112; second is that language is so broad that it causes claim to have a potential scope of protection beyond that which is justified by specification disclosure; this ground stems from first paragraph of section 112....” This statement actually supports the examiner’s 112, 1st and 2nd rejections. Specifically, the claims are rejected as indefinite because the scope of the claim is not clear. In other words, what applicant intends to encompass by the claim language is not definite. The scope of the claim changes with other contributions made to the art (i.e., CIP applications).

Furthermore, the claims are not enabled under 112, 1st for the full scope of the recited claim. Once again, note future contributions to the art such as the CIP applications.

33. In summary, the examiner contends the claims are indefinite and non-enabled. The term “orthogonally ambiguous” is a descriptive property not functional. Its descriptive of a desired achievement, but lacks instruction of how to achieve. The specification clearly sets forth a method of achieving this desired goal, but said method is merely one of many known or future known methods, as evidenced by applicant’s own CIP applications.

Hence, the full scope of the claims are non-enabled.

34. As noted in the interview, the proposed amendment would be sufficient to overcome all the standing rejections except for the 112, 2nd Slob rejection and the new 112, 1st enablement rejection. To obviate these rejections, it is suggested applicant amend the claims to include subject matter from the specification, page 4, line 4 – bottom of page 5,

Application/Control Number: 09/783,354

Page 18

Art Unit: 1771

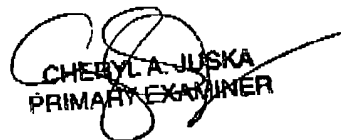
which discusses the factors and rules for creating an orthogonally ambiguous pattern for carpet tiles.

Conclusion

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHERYL A. JUSKA
PRIMARY EXAMINER

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June 17, 2004